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SUBJECT: Reply Brief

Serial No.: U.S. Patent Application 10/051,486, filed January 18, 2002

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Appellant:)
John D. Phillips) Examiner: A. Phi Dieu Tran
)
Application No.: 10/051,486) Group Art Unit: 3637
)
Filing Date: January 18, 2002) Attorney Docket: 24457B
)
Title: Laminated Roofing Shingle Having Staggered)
Shadow Lines and Method of Making the Same)

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REPLY BRIEF

Honorable Sir:

This reply brief is in response to an Examiner's Answer, dated June 14, 2006. In the answer, the Examiner mainly attacked three points of Appellant's arguments, as set forth in the Appellant's appeal brief, dated May 15, 2006. In particular, this reply brief is responsive to the Examiner's comments regarding 1) elements not taught by the art of record, 2) lack of motivation to combine, and 3) use of impermissible hindsight, as set forth under the following headings.

1) Elements not taught in the Art of Record

With respect to the Examiner's answer to Appellant's arguments that missing elements from Weaver are not taught by Hannah or Corbin, Appellant respectfully points out that Weaver cannot be modified by Hannah and Corbin to show all the claim limitations.

Weaver fails to disclose or teach **an overlay with a tab having a first shadow line and a remaining portion**, wherein the first shadow line and the remaining portion are on an outer surface of the tab, and further wherein the first shadow line

extends from the leading edge of the tabs to the remaining portion of the tabs, as admitted by the Examiner (see Office Action at page 3, line 1 and page 5, lines 8-10).

For these teachings the Examiner relies on Hannah and Corbin. The Examiner alleges that Hannah teaches a tab having a darker first shadow line illustrated on the tab of the shingle. However, Appellant respectfully submits that Hannah fails to teach a shingle having **an overlay with a tab with a darker first shadow line illustrated on the tab**. Hannah does show a laminate roofing shingle having layers, including an overlay and an underlay, and the overlay has a tab. However, the tab does not have a darker first shadow line. Instead, the tab appears to be completely uniformly colored or shaded and the underlay appears to be entirely darker than the overlay, with a portion of the underlay extending beyond a leading edge of the overlay. This portion is thus a darker revealed portion of the underlay. It is this darker revealed portion of the underlay that the Examiner is interpreting as a darker first shadow line. However, this interpretation is beyond the teaching of Hannah because Hannah discloses a laminate formed of two layers, one darker than the other, and **not an overlay having a darker first shadow**, as claimed. In this regard, Weaver and Hannah, when combined, fail to teach **an overlay with a tab having a darker first shadow line**, as set forth in the claims.

For at least the same reasons, Weaver and Hannah fail to teach a shingle having an overlay with a tab having **different coloring schemes**, together with other features of the invention, to provide an aesthetic surface, for example, a tab with the use of a darker shadow line and the remaining area, with the remaining area of the tab being lighter in color than the shadow line.

In view of the foregoing comments and arguments, Appellant respectfully submits that claim elements (i.e., **an overlay having a darker first shadow or different coloring schemes**) missing from Weaver are not taught by Hannah.

The Examiner relies on Corbin for Corbin's disclosure of a shingle with an aesthetic surface formed by having a layer of the shingle formed of different bands of

color. However, Corbin, like Weaver and Hannah, fails to teach or suggest an overlay with a tab having a darker shadow line, or different colored granules, situated in relation to a leading edge of the tab, as set forth in the claims. To this end, the claim elements missing from Weaver and Hannah are also missing from Corbin.

2) No Motivation to Combine

With respect to the Examiner's answer to Appellant's arguments there is no motivation to combine the teachings of Weaver, Hannah and Corbin. Appellant respectfully submits that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992).

The Examiner alleges that the motivation to combine is found in the references themselves. With respect to claims 1, 7 and 12, the Examiner admits that Weaver fails to disclose or teach an overlay with a tab having a first shadow line and a remaining portion. For this teaching, the Examiner relies on Hannah, and Hannah is a crucial nexus for combining Weaver and Corbin. However, Hannah fails to teach a shingle having an overlay with a tab with a darker first shadow line illustrated on the tab. Instead, Hannah teaches an overlay having a tab and an underlay with a darker revealed portion extending beyond a leading edge of the overlay. There can be no motivation to combine Weaver and Hannah since Hannah is devoid of any teaching of an overlay with a tab with a darker first shadow line illustrated on the tab. Without a motivation to combine Weaver and Hannah, there is no motivation to further combine Corbin.

With respect to claims 21, 22 and 23, the Examiner alleges that Hannah teaches a tab having the leading edge that is generally darker than a remaining portion of the overlay, particularly referring Appellant to Fig. 23. The Examiner interprets Hannah as teaching tabs made of an overlay and underlay with coloring (see the first full paragraph of the Examiner's Answer, dated June 14, 2006). However, the claim limitations do not refer to tabs made of an overlay and underlay but instead refer to an **overlay with a tab with a shadow line and a remaining portion**. There can be no motivation to combine Weaver and Hannah since Hannah is devoid of any teaching of an **overlay with a tab with a leading edge that is generally darker than a remaining portion of the overlay**. Without a motivation to combine Weaver and Hannah, there is no motivation to further combine Corbin.

With respect to claims 24 and 34, the Examiner points out that Hannah shows tabs with two different colored portions, again referring Appellant to Fig. 23, and alleges that the application of different colors on two different layers does not negate the fact that Hannah shows tabs with different coloring schemes. In forming this conclusion, the Examiner disregards Appellant's claim limitations referring to an **overlay with a tab with a shadow line and a remaining portion**, which is completely lacking in Hannah. There can be no motivation to combine Weaver and Hannah since Hannah is devoid of any teaching of the claim limitations. Without a motivation to combine Weaver and Hannah, there is no motivation to further combine Corbin.

3) Impermissible Hindsight.

In response to Appellant's arguments that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, the Examiner points out that it is recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning, but as long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed

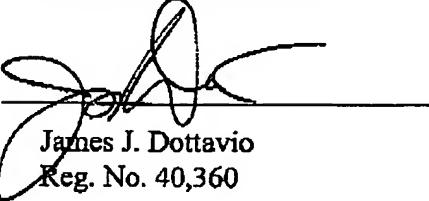
invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper, citing *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

As stated above, Appellant respectfully submits that none of the art of record, taken either singly or in combination, teaches or suggests **an overlay with a tab with a shadow line and a remaining portion**. In the absence of such teaching or suggestion, the knowledge of the claim limitations must have been gleaned only from the Appellant's disclosure. Accordingly, the Examiner's conclusion of obviousness must have been based upon improper hindsight reasoning.

Conclusion

In view of the above remarks, Appellant has shown that the claims are in proper form for allowance, and the invention, as defined in the claims herein, is neither disclosed nor suggested by the references of record. In view of the foregoing arguments, the rejections of claims 1-45 are in error, and should be reversed. Appellant accordingly respectfully requests that the Board of Patent Appeals and Interferences reverse the Examiner as to all rejections.

Respectfully submitted,



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